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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,837	03/26/2001	G. Eric Engstrom	112076-138339	9404
25943 7590 11/13/2007 SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			EXAMINER CASLER, TRACI	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 11/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/817,837		ENGSTROM, G. ERIC	
	<b>Examiner</b>		<b>Art Unit</b>	
	Traci L. Casler		3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to papers filed on December 27, 2004.

Claims 45-68 are pending.

Claims 45-68 are rejected.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim limitation of "transmitting by the first server to the client device or the second server the generated personality profile to the second server of the second service provider." The examiner is unclear as to what is being transmitted to whom it is being transmitted. For the sake of prosecution the examiner is reading the claim to mean the profile is being sent by the first server to the client device or the second server.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 45-68 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,609,106 Robertson; System and Method for Providing Multi-Merchant Gift Registry Services over a Distributed Network.

3. As to claim 45 and 56 A method of operation, performed by a device, comprising: receiving by the device, from a first server of a first service provider, a request for registration information for a user of the device, the registration information requested including one or more personality characteristics; **Robertson teaches a user being asked(requested) to submit registration information which includes one or more personality characteristics(Fig. 15-16 and C. 9 I. 55-60)**

**generating by the device, or the device** causing a second server of a second service provider to provide, *a personality profile to portray a desired persona, based at least in part on a service provided by the first service provider*, the second service provider providing a personality

service; and **Robertson teaches the user(user computer) selecting the user registration and submitting information to a part of the user profile(Fig. 21)**

**transmitting by the device**, or the device causing the second server to transmit, *the personality profile to the first server to respond to the request*. **Robertson teaches the user (user computer/device) submitting registration/profile information to the first server.**

3. As to claim 46 Robertson teaches the user(device) requesting information from the first server(Fig. 15 Ref 265 Fig. 30).

4. As to claims 46-48 Robertson teaches the first service provider providing the profile. The claims do not carry any patentable weight as they fail to further limit independent claim. *Milton v. National Association of Securities* 67 USPQ2d 1614 (CAFC 2003) the courts stated that whereby(wherein) clauses in a method claim is not given patentable weight when it simply expresses the intended. The terms of the claims were not ignored but analyzed in each instance to determine impact. Since examiner is reading the independent claim to be generating the personality profile by the device not the second server these limitations hold no patentable weight.

5. As to claim 49 Robertson teaches the profile transmitted to the first server(Fig. 16 Ref. 295)

As to claim 50 Robertson teaches the characteristics as interests and biographical data(Fig. 16 and 17).

6. As to claim 52 A method of operation, performed by a first server of a first service provider providing a personality service, comprising;
7. receiving by the first server, from a client device, a request to provide a personality profile for a user of the client device, **Robertson teaches the user selecting to register for a server to create a profile, (Fig. 16)** (Fig. 16) for responding to a request of a second server of a second service provider, **The profile is able to be used to supply marketing information to Service providers(C. 3 I. 55-57).**
8. requesting for registration information for the user, the registration information requested including one or more personality characteristics; **Robertson teaches the user registering personal information such as name address phone and special events.(C. 9 I. 55-60).**
9. providing by the first server, a personality profile for response, based at least in part on a service provided by the second service provider; and **(Robertson teaches the profile created based on a SP merchants based on user profile interests(C. 10 I. 14-16)**
10. transmitting by the first server to the client device or the second server the generated personality profile to the second server of the second service provider. **Robertson teaches transmitting the profile to the user computer(Fig. 17 and Fig. 21).**

11. As to claim 53 Robertson teaches receiving personality characteristics(Fig. 23).
12. As to claim 54 Robertson teaches identifying(ascerting) the services(type of business) of the second service provider based on communication between second server and first server(SP registration) Fig. 24 and 29).
13. As to claim 55 Robertson teaches identifying several people to purchase gifts for and the user selecting one(Fig. 32-33).
14. As to claim 56 Robertson teaches generating at least one profile(C. 10 I. 14-16).
15. As to claim 57 Robertson teaches the personality characteristics as hobbies interests biographical data(Fig28 Fig. 16-17).
4. As to claim 64 Robertson teaches an apparatus with a storage medium(Fig. 1 Ref. 71) And a processor coupled to the storage to execute instructions.(Fig. 1 Ref. 50).
5. As for the limitations of the functions of the **apparatus** or what the **apparatus** does, i.e. "wherein the instructions "enable the apparatus" these carry no patentable weight in an apparatus claim. Apparatus claims should cover what a device is or structures or structural elements, not what a device does. See Hewlett-Packard Co. vs. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).
6. As for Dependent Claims 59-63 and 65-68, which further deal with other functions of the **apparatus**, they are rejected for the same.


**Conclusion**

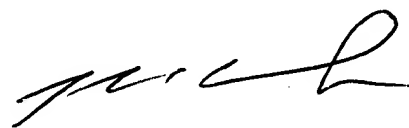
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TLC

  
Au3629

  
JOHN A. WEISS  
SUPERVISOR OF EXAMINER  
TECHNOLOGY CENTER 3600

  
WYNN W. COGGINS  
TECHNOLOGY CENTER DIRECTOR